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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,078	03/01/2002	Masatoshi Yokota	0754-0173P	9128

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EXAMINER
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BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/085,078

Applicant(s)

YOKOTA, MASATOSHI

Examiner

David Buttner

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims 1, 3, 4 and 7-9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cavallaro '491 Publication.

Cavallaro produces urethane covered golf balls. The urethane is formed from a polyol/polyisocyanate prepolymer and curing agent (paragraph 65). The polyol may be poly(hexamethylene carbonate) glycol of 200-4000 MW (paragraph 61). Cavallaro lists the same curing agents (paragraph 63) as applicant. The examples (Table 1) exhibit the same free -NCO content and equivalent ratio as applicant desires. The urethane cover has a Shore D under 45 (abstract).

Claims 1, 3, 4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Cavallaro '491 Publication in view of Murai's '691.

Cavallaro lists a number of polyols including poly (hexamethylene carbonate) glycol, but does not point out the advantages thereof.

Murai's background (column 1, lines 32-39, 54-60) teaches the advantages of using such a polycarbonate diol instead of polyester or polyester diols. It would have been obvious to select poly(hexamethylene carbonate) glycol from Cavallaro's list for the expected advantages.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Kakiuchi '286 Patent.

Kakiuchi produces urethane covered golf balls. The urethane cover has a Shore D of 45-55 (column 4, line 2). The urethane can be based hexanediol carbonate glycol (column 3, line 37) of 1000-3000 MW (column 3, line 40). This high MW polyol is

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reacted with diisocyanate and chain extender (column 3, lines 41-53). The chain extenders correspond to applicant's curing agent.

Kakiuchi does not indicate the high MW polyol and diisocyanate are pre-reacted, but there is no reason to believe the final product is any different from applicant's final product (MPEP 2113).

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Kakiuchi '286 Patent in view of Peter '313.

Kakiuchi does not teach pre-reacting his high MW polyol with diisocyanate.

Peter teaches the prepolymer method as an alternative to concurrent reaction (column 7, lines 40-53). It would have been obvious to use either method and result in substantially the same final product.

Claims 1, 3, 4 and 7-9 are rejected under 35 USC 102(b) as anticipated by or in the alternative under 35 U.S.C. 103(a) as being unpatentable over the Ichikawa '189 Patent.

Ichikawa produces urethane covered golf balls. The urethane cover has a Shore D of 38-58 (column 4, line 32). The urethane can be based hexanediol carbonate glycol (column 3, line 58) of 1000-3000 MW (column 3, line 62). This high MW polyol is reacted with diisocyanate and chain extender (column 3, lines 49). The chain extenders correspond to applicant's curing agent.

Ichikawa does not indicate the high MW polyol and diisocyanate are pre-reacted, but there is no reason to believe the final product is any different from applicant's final product (MPEP 2113).

Claims 1, 3, 4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Ichikawa '189 Patent in view of Peter '313.

Ichikawa does not teach pre-reacting his high MW polyol with diisocyanate.

Peter teaches the prepolymer method as an alternative to concurrent reaction (column 7, lines 40-53). It would have obvious to use either method and result in substantially the same final product.

Applicant's arguments filed September 3, 2003 have been fully considered but they are not persuasive.

Applicant argues Kakiuchi is directed to thermoplastic urethane rather than thermosett urethanes.

Applicant has chosen not to limit the claims to thermosett polyurethane's. Limitations from the specification are not read into the claims (MPEP 2145). The prepolymer/curing agent technique for producing polyurethane's does not necessarily result in thermosett polyurethane. If applicant disputes this, the examiner can point to Wu '176 column 6, line 33-35 to show otherwise.

Applicant argues the Declaration by Kamitani removes Cavallaro as prior art.

Ms. Kamitani does not appear to be a qualified party to make a 1.131 declaration according to the rules (MPEP 715.04). Therefore, the declaration cannot be relied upon.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can generally be reached on weekdays from 10 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 308-2340. The fax phone number for the organization where this application is assigned 571-272-1119.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

DAVID J. BUTTNER  
PRIMARY EXAMINER

D. Buttner/dh  
December 31, 2003

*David Buttner*